

**REMARKS**

Claims 1-13 remain pending in the application. Claims 1 and 4 have been amended to recite (A) cross-linked silicone particles with an average particle size of from 0.5 to 500  $\mu\text{m}$ . Support for the amendments to claims 1 and 4 can be found in at least paragraphs [0011] and [0023] of United States Patent Application Publication No. 2006/0127338 A1. No claims have been added; thus, no new matter has been added through the present Amendment.

**Claim Rejections Under 35 U.S.C. §103(a):**

Claims 1-8 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable as obvious over United States Patent No. 5,928,660 to Kobayashi et al. (the '660 patent) and International Publication No. WO 02/094213 A2 to Tanaka et al. (the '213 publication), as evidenced by Webster's Ninth New Collegiate Dictionary and information regarding siloxane polymerization available on the Dow Corning website. The Applicants respectfully traverse this rejection on the basis that the Examiner has not established a *prima facie* case of obviousness of original claims 1 and 4 over the '660 patent and the '213 publication. Furthermore, in view of currently amended claims 1 and 4, the Applicants respectfully submit that the present claims, as amended, are both novel and non-obvious over the prior art.

To summarize the relevant standards that the Examiner must apply in performing an obviousness analysis of the present claims, 35 U.S.C. §103 forbids issuance of a patent

when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). As the Examiner is aware, the question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (2007). Further, the MPEP provides seven examples of rationales for establishing a *prima facie* case of obviousness. Should the Examiner utilize any other methodology to establish obviousness, a commensurate level of specificity is required.

As the Examiner is also aware, the Federal Circuit has recently confirmed the test for *prima facie* obviousness for chemical compounds "is consistent with the legal principles enunciated in KSR," and thus, "in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound." *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, Slip op. at 10 (Fed. Cir. 2007) (footnote omitted). In particular, the *Takeda* Court notes,

[t]he test for *prima facie* obviousness for chemical compounds is consistent with the legal principles enunciated in KSR. While the KSR Court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the Court

acknowledged the importance of identifying “**a reason** that would have prompted a person of ordinary skill in the relevant field to **combine the elements in the way the claimed new invention does**” in an obviousness determination. KSR, 127 S. Ct. at 1731. Moreover, the Court indicated that there is “no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis.” Id. As long as the test is not applied as a “rigid and mandatory” formula, that test can provide “helpful insight” to an obviousness inquiry. Id. Thus, in cases involving new chemical compounds, **it remains necessary to identify some reason** that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound. *Id.* (emphasis added)

The Applicants respectfully submit that the Examiner’s position relative to obviousness of original claims 1 and 4 over the ‘660 patent and the ‘213 publication is deficient and violates the standards for establishing a *prima facie* case of obviousness set forth by *Graham*. The Applicants respectfully submit that for the reasons set forth below, original claims 1 and 4 are both novel and non-obvious over the prior art.

The Examiner asserts that the ‘660 patent discloses compounds corresponding to components (A), (C), and (D) of the present invention. Additionally, the Examiner correctly acknowledges that the ‘660 patent does not disclose component (B) of the present invention, i.e., the ‘660 patent does not disclose specific types of chemicals such as N-hydrocarbon taurines as surfactants. The Examiner turns to the ‘213 publication to teach the use of N-acyl-, N-hydrocarbon taurines as surfactants (allegedly corresponding to component (B) of the present invention) to stabilize a dispersion of a raw material for cosmetic use comprising a polyorganosiloxane and water (Abstract and page 9, lines 1-9 of the ‘213 publication). Therefore, the Examiner contends that it would have been *prima facie* obvious to a skilled

artisan at the time of the present invention to substitute one surfactant type by the other for the same intended use.

The Applicants respectfully disagree and submit that for the present invention involving aqueous suspensions of cross-linked silicone particles (per original claim 1) and aqueous emulsions of oil containing cross-linked silicone particles (per original claim 4), there is **no reason** that would have prompted a chemist to combine the components of the claimed new invention.

Importantly, the '213 publication disparages the use of (B) the N-acylalkyltaurine and/or salt thereof in conjunction with an average particle size of the emulsion composition of the '213 publication of greater than 0.15  $\mu\text{m}$ . That is, the '213 publication states that when the particle size is greater than 0.15  $\mu\text{m}$ , "the viscosity of the emulsion may become too high, resulting in a deterioration in its flowability and operating characteristics" (page 4, lines 10-13). As summarized in MPEP §2143.01.V, **a proposed modification cannot render the prior art unsatisfactory** for its intended purpose. That is, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Since the '660 patent discloses an aqueous suspension of a powdered silicone rubber with a mean particle size of 0.1 to 500  $\mu\text{m}$  (see claim 1 of the '660 patent), the Applicants respectfully assert that the Examiner's proposed modification to combine component (B) of the '213 publication with the cosmetic raw material of the '660 patent would, by the '213 publication's own admission, render the cosmetic raw material of the

'660 patent **unsatisfactory for its intended purpose**. Said differently, the '213 publication clearly teaches away from the combination of component (B) of the '213 publication with the cosmetic raw material of the '660 patent. Thus, there is **no reason** that would have prompted a chemist to combine the components of the claimed new invention to establish *prima facie* obviousness of the invention.

Moreover, contrary to the Examiner's contention that it would have been *prima facie* obvious to a skilled artisan to substitute one surfactant type for another surfactant type for the same intended use, the '213 publication discourages particle sizes greater than 0.15 µm when used with 5 to 300 parts by weight of its component (B) per 100 parts by weight of its component (A) (see page 4, lines 7-13 of the '213 publication). Therefore, especially when faced with the language of the '213 publication that teaches away from particles with an average particle size of from 0.5 to 500 µm, there is **no reason** that would prompt a chemist to combine components (A), (B), and (C) of currently amended claim 1. Likewise, there is no reason that would prompt a chemist to combine components (A), (B), (C), and (D) of currently amended claim 4. That is, there is **no suggestion or motivation** in either the '660 patent and the '213 publication individually or in a combination of these references to prepare the aqueous suspension of currently amended claim 1 or the aqueous emulsion of currently amended claim 4 of the present invention. The Applicants respectfully submit that the '660 patent never discloses the aqueous suspensions of cross-linked silicone particles or the aqueous emulsions of oil of currently amended claims 1 and 4, and the Examiner has only arrived at the proposed modification of the '660 patent by using the present application as a roadmap, i.e., via

impermissible hindsight. Therefore, for at least the reasons set forth above, the Applicants respectfully submit that claims 1-8 and 11 are both novel and non-obvious over the prior art.

Claim Rejections Under 35 U.S.C. §112:

Claims 9-10 and 12-13 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Applicants respectfully traverse this rejection on the basis that currently amended claims 1 and 4 contain sufficient antecedent basis for claims 9-10 and 12-13, respectively. Therefore, the Applicants respectfully submit that claims 9-10 and 12-13 are definite, novel, and non-obvious over the prior art.

In particular, the Examiner contends that claims 9-10 and 12-13 are vague and indefinite and that there is no prior antecedent basis for the specific structures of N-acyl-, N-hydrocarbon taurines in claims 1 and 4 from which claims 9-10 and 12-13 respectively depend. The Applicants respectfully disagree. In particular, currently amended claim 1 specifies component (B) as N-acyl-, N-hydrocarbon taurines represented by general formula (I) **and/or their salts**, and claims 9 and 10 merely further define the **salt**. Similarly, currently amended claim 4 specifies component (B) as N-acyl-, N-hydrocarbon taurines represented by general formula (I) **and/or their salts**, and claims 12 and 13 merely further define the **salt**. That is, the Applicants respectfully clarify that currently amended claims 1 and 4 contain sufficient antecedent basis for claims 9-10 and 12-13, respectively. Therefore,

the Applicants respectfully submit that claims 9-10 and 12-13 are neither vague nor indefinite, but rather are definite, novel, and non-obvious over the prior art.

In view of the foregoing, the Applicants respectfully submit that claims 1-13 are both novel and non-obvious over the prior art including over the '660 patent and the '213 publication. As such, the Applicants submit that the claims are now in condition for allowance and respectfully request such allowance.

This response is timely filed; thus, it is believed that no further fees are presently due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys, P.C. for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS, P.C.**

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/Ellen M. Schwab/  
Ellen M. Schwab, Registration No. 61,077

The Pinehurst Office Center, Suite 101  
39400 Woodward Avenue  
Bloomfield Hills, MI 48304-5151  
(248) 723-0442